

**REMARKS**

Claims 1, 3-8, 11-13 and 15-20 are pending in this application. By this Amendment, claims 1, 8, 13 and 20 are amended and claims 2, 9, 10 and 14 are canceled. No new matter has been added.

Applicants appreciate the courtesies shown to Applicants' representative Moshe Wilensky by Examiners Myles Robinson and Twyler Lamb in the personal interview conducted September 4, 2007. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

**I. Objections to Drawings**

The Office Action objects to the drawings under 37 C.F.R. §1.83(a) asserting that the drawings do not show every feature of the claimed invention. Specifically, the Office Action asserts that the printing results using the first set of image pixels (as recited in claims 1 and 13), the output image (as recited in claim 9), the printer, the contone rendering module, the image output terminal (as recited in claim 13), how the end print is visually substantially equivalent to the printed result, and the process wherein the manner is indistinguishable to the human eye must be shown in the drawings or the features canceled from the claims.

Applicants respectfully assert that claims 1, 3-8 and 11-12 recite a method. Accordingly, the specification and drawings need only describe to one of ordinary skill in the art how the method is accomplished and need not disclose the end result of the method in the drawings. Likewise, the printer recited in claims 13 and 15-20 is recited to be a common printer well known in the art, thus the results printed from such a printer need not be disclosed if the claimed method used to compress the data sent to that printer is fully disclosed. Applicants respectfully request that the objection be withdrawn.

## **II. Objections to the Claims**

The Office Action objects to claims 2 and 14 because of informalities and spelling errors. Claims 2 and 14 have been canceled and the subject matter they recited incorporated into claims 1 and 13. However, the spelling errors indicated have been corrected in claims 1 and 13. Accordingly, withdrawal of the objection is respectfully requested.

The Office Action also objects to claim 20 asserting that the word "algorithms" should be the singular "algorithm." Claim 20 has been amended in accordance with the Examiner's helpful suggestion. Accordingly, withdrawal of this objection is respectfully requested.

## **III. §101 and §112 Rejections**

The Office Action rejects claims 1-7 and 13-20 under 35 U.S.C. §112, first paragraph on the grounds that they are not enabled. The Office Action asserts that the claim language reciting the printing of a result is not enabled by the specification. This rejection is respectfully traversed.

In accordance with the agreement reached during the September 4, 2007 interview claims 1 and 13 have been amended to remove the term "printed result" and replace it with the term "final image." Accordingly, Applicants respectfully assert that the specification now fully discloses the subject matter recited in claims 1 and 13 and claims 3-7 and 15-20 depending therefrom. Accordingly, withdrawal of this rejection is respectfully requested.

The Office Action also rejects claims 1-20 under 35 U.S.C. §112, first paragraph on the grounds that the final paragraph of the specification discloses claims that encompass future, unforeseen modifications, improvements, alternatives, and various equivalents. This rejection is respectfully traversed.

In accordance with the agreement reached during the personal interview of September 4, 2007, the final paragraph of the specification has been deleted and replaced with the agreed upon text stating: "It will be appreciated by those of ordinary skill in the art that the above

are merely examples. Other embodiments may be readily apparent to those of ordinary skill in the art." Accordingly, withdrawal of the rejection of claims 1-20 is respectfully requested.

The Office Action next rejects claims 1-20 under 35 U.S.C. §101 for lack of utility. The Office Action also rejects claims 1-20 under 35 U.S.C. §112, first paragraph, for lack of a well established utility. These rejections are respectfully traversed.

The Office Action asserts that claims 1, 8 and 13 are drawn to an invention that does not transform an article or physical object to a different state or thing. Specifically, the Office Action asserts that because the initial image produced by the printing hints and the final image produced by the altered printing hints are identical, no tangible article has been transformed.

Claims 1, 8 and 13 have been amended to recite that the altered printing hints require less memory space than the original printing hints. Thus, in accordance with the agreement reached during the September 4, 2007 personal interview, Applicants respectfully asserts that claims 1-20 now have a proper utility. Accordingly, withdrawal of the §101 and §112 rejections are respectfully requested.

The Office Action also rejects claims 1-20 under 35 U.S.C. §101 on the grounds that the specification does not disclose the future alternatives described by the final paragraph of the specification. This rejection is respectfully traversed.

In accordance with the agreement reached during the September 4, 2007 personal interview the final paragraph in the specification has been removed. Thus, withdrawal of this rejection is respectfully requested.

#### **IV. §102 and §103 Rejections**

The Office Action rejects claims 1, 8 and 13 under 35 U.S.C. §102(e) over U.S. Patent Publication No. 2004/0227963 to Jacobsen, et al. (hereafter "Jacobsen"). The Office Action also rejects claims 1, 8, 13 and 20 under 35 U.S.C. §102(b) over U.S. Patent Publication No.

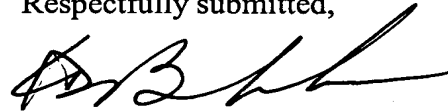
2002/0076103 to Lin, et al. (hereafter "Lin"). The Office Action further rejects claims 4, 5, 11, 12, 16 and 17 under 35 U.S.C. §103(a) over Jacobsen in view of U.S. Patent No. 5,075,779 to Lefebvre, et al. (hereafter "Lefebvre"). Finally, the Office Action rejects claims 4, 5, 11, 12, 16 and 17 under 35 U.S.C. §103(a) over Lin in view of Lefebvre. These rejections are respectfully traversed.

Applicants thank the Examiner for the indication of the allowability of claims 2, 3, 6, 7, 9, 10, 14, 15, 18 and 19. Independent claim 1 has been amended to incorporate the allowable subject matter of claim 2. Likewise, claim 8 has been amended to incorporate the allowable subject matter of claims 9 and 10. Finally, claim 13 has been amended to incorporate the allowable subject matter of claim 14. Accordingly, in light of the agreement reached at the September 7, 2007 personal interview, Applicants respectfully assert claims 1, 8 and 13 are now in condition for allowance. Furthermore, the remainder of the claims depend from these three allowable claims, and as such are also now in condition for allowance. Thus, Applicants respectfully request the withdrawal of all the §102 and §103 rejections.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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